

REMARKS

I. 35 U.S.C. § 112, Second Paragraph

In the Office Action, the Examiner has rejected Claims 1-19 under 35 U.S.C. § 112, second paragraph. Applicant has amended the claims to more clearly point out and distinctly claim the subject matter of the present invention. Thus, Applicant respectfully submits that the amendments overcomes the Examiner's rejections under 35 U.S.C. § 112. Such action is earnestly solicited.

II. 35 U.S.C. § 103(a)

In the Office Action, the Examiner has rejected Claims 1-7 and 9-16 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hoang et al., U.S. Patent 6,449,052 in view of Roach et al., U.S. Patent 5,434,394, in view of Cohen et al., U.S. Patent 6,505,171, and further in view of Weiss, U.S. Patent 6,511,377. The Examiner has rejected Claim 8 under 35 U.S.C. § 103(a) as allegedly being anticipated by Roach et al., U.S. Patent 5,434,394, in view of Cohen et al., U.S. Patent 6,505,171, and further in view of Weiss, U.S. Patent 6,511,377 and further in view of an Official Notice. The Examiner has rejected Claims 17-18 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hoang et al., U.S. Patent 6,449,052 in view of Cohen et al., U.S. Patent 6,505,171. The Examiner has rejected Claim 19 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hoang et al., U.S. Patent

6,449,052 in view of Cohen et al., U.S. Patent 6,505,171 and further in view of Yamada, U.S. Patent 6,336,100.

Applicant respectfully disagrees with the Examiner's conclusion. Applicant claims a system for secure and private on-line shopping. The system has a brick and mortar store which houses a plurality of computers. The store functions as an on-line shopping store where individuals can order merchandise and have the merchandise delivered to the store for pick-up or to an alternative address. The system further uses an on-line store shopping card. The online shopping card is used for purchasing items from the on-line retailers. The online shopping card is a pre-paid card having an assigned monetary value. Individuals using the on-line store shopping card can return the on-line store shopping card for cash on unused credit after shopping at the store.

The Examiner contends that Hoang discloses an on-line shopping store comprising a plurality of computers. However, the Examiner acknowledges that Hoang fails to disclose or anticipates a brick and mortar store which houses a plurality of computers where individuals may order merchandise and have the merchandise sent to the store for pick-up.

The Examiner contends that Roach discloses the above claimed elements in Col. 3, line 51 - Col. 4, line 21. Applicant respectfully disagrees with the Examiner. Roach discloses a store having a warehouse area in the back of the store. Individuals can order merchandise from the store and the merchandise will be sent from the back of the store (warehouse area) and delivered to the

front of the store to the customer. The system is similar to that used by Sears. What Roach fails to disclose or anticipate is a plurality of computers coupled to different on-line retailers where individuals can order merchandise and have the merchandise delivered to the store for pick-up or to an alternative address. Roach also fails to disclose or anticipate an on-line store shopping card. The online shopping card is used for purchasing items from the on-line retailers. The online shopping card is a pre-paid card having an assigned monetary value. Individuals using the on-line store shopping card can return the on-line store shopping card for cash on unused credit after shopping at the store.

The Examiner acknowledges that Hoang fails to disclose a pre-paid card. However, the Examiner contends that Cohen discloses a pre-paid card. Applicant respectfully disagrees. Cohen does not disclose the ability to get a pre-paid cash card from the retailer, use the cash card to order merchandise, and then return the cash card for any unused portions. All pre-paid cash cards require the user to use the funds on the cash card. Money is never returned by the company that sells the pre-paid cards.

The Examiner acknowledges that none of the above references disclose that one may return the cash card for any unused portions. However, the Examiner claims that in the field of cashless casino gambling as disclosed in Weiss, one can do this. Applicant respectfully disagrees with the Examiner. One cannot use the card disclosed in Weiss to make online purchases. Second,

Weiss relates to casino gambling. Casino gambling is not an analogous field as claimed by the Examiner. Three of the above references disclosed by the Examiner (Hoang et al., Roach et al., and Weiss) are all in different U.S. and International classifications.

Furthermore, the legal standard for obviousness under 35 U.S.C. 103 has been the subject of much analysis. The Federal Circuit has enunciated several guidelines in making a Sec. 103 obviousness determination.

A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art. In re Bell, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed Cir. 1993) (quoting In re Rinehart, 531 F.2d 1048, 1051 (C.C.P.A. 1976)).

{T}he examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. "{The Examiner} can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." (Emphasis added) In re Fritch, 972 F.2d 1260, 1265, 23 U.S.P.Q.2d 1780, 1783 (Fed Cir. 1992) (citing In re Piasecki, 745 F.2d 1468, 1471-72, 223 U.S.P.Q. 785, 787-88 (Fed. Cir. 1984) and In re Fine, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988) (citing In re Lalu, 747 F.2d 703, 705, 223 U.S.P.Q. 1257, 1258 (Fed. Cir. 1988))).

For the Examiner to establish a prima facie case of obviousness, the Examiner must contend that the teachings from the prior art itself or that knowledge generally available to one of ordinary skill in the art would appear to suggest the claimed subject matter to a person of ordinary skill in the art.

Perhaps the Examiner somehow believes that one of ordinary skill in the art could conceivably combine the cited references to produce Applicants' claimed invention. But the Federal Circuit has held that

obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. (Emphasis added)
In re Bell, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993) (citations omitted).

Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." (Emphasis added) But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." (Emphasis added)
In re Fine, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988) (citing In re Keller, 642 F.2d 413, 425, 208 U.S.P.Q.871, 881 (C.C.P.A. 1981) and ACS Hosp. Sys. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984)).

Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination.
Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 U.S.P.Q.2d 1434, 1438 (Fed. Cir. 1988) (citing Lindemann, Maschinenfabrik GmbH v. American Hoist and Derrick Co., 730 F.2d 1452, 1462, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984)).

Applicant respectfully yet strenuously contends that the Examiner has shown no teaching nor suggestion in any one of the cited references or elsewhere of Applicant's claimed apparatus to support a conclusion of obviousness.

Applicant respectfully submit that the Examiner has fallen into the common trap of hindsight reconstruction, which has

been frequently denounced by the Federal Circuit as inappropriate to support a finding of obviousness.

The obviousness standard, while easy to expound, is sometimes difficult to apply. It requires the decisionmaker to return to the time the invention was made. "the invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time."

Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1050-51, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988) (quoting Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1138, 227 U.S.P.Q. 543, 547-548 (Fed. Cir. 1985)).

It is clear from the Examiner's rejection that, absent the "blueprint" of Applicants' disclosure, the prior art has no suggestion or teaching of Applicants' claimed invention. The Federal Circuit has also stated:

It is improper to use the patent as an instruction manual to lead to elements of the prior art.

Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1568 (Fed. Cir. 1987).

It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious.

In re Fritch, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992) (citing In re Gorman, 933 F.2d 982, 987, 18 U.S.P.Q.2d 1885, 188 (Fed. Cir. 1991)).

It is very clear from the Examiner's language that Applicants' claimed invention is only rendered invalid for obviousness if the Applicants' claimed invention is used as an instruction manual, or template, for modifying the cited prior art. Absent the knowledge gleaned from Applicants' disclosure, there is no suggestion or teaching in the cited prior art or in the general knowledge in the art to support the Examiner's assertion that

Applicants' claimed invention would have been obviousness to one of ordinary skill in the art. The Federal Circuit has also stated:

When prior art references require selective combination...to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 U.S.P.Q.2d 1434, 1438 (Fed. Cir. 1988) (citing Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985)).

The Examiner has cited no reason for modifying the cited references to allegedly achieve Applicants' claimed invention other than the knowledge gleaned from Applicants' disclosure. For this reason the Examiner has failed to establish a prima facie case of obviousness based on a combination of these specific references.

For the above reasons, Applicant respectfully submit that Claims 1-19 are patentably distinguishable over the cited prior art. Such action is earnestly solicited.

III. Conclusion

Applicant respectfully submit that Applicant's claimed invention is deserving of patent protection because it describes a useful and functioning apparatus which is patentably distinguishable over the prior art.

In conclusion, Applicant respectfully submits that this Amendment Letter, including the amendments to the Claims, and in view of the Remarks offered in conjunction therewith, are fully responsive to all aspects of the objections and rejections tendered by the Examiner in the Office Action. Applicant respectfully

submits that he has persuasively demonstrated that the above-identified Patent Application, including Claims 1-19 are in condition for allowance. Such action is earnestly solicited.

If the foregoing does not place the case in condition for immediate allowance, the Examiner is respectfully requested to contact the undersigned for purposes of a telephone interview.

If there are any fees incurred by this Amendment Letter, please deduct them from our Deposit Account NO. 23-0830.

Respectfully submitted,



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